Santa Clara University
School of Law

Santa Clara Law Review

Volume 12 | Number 1 Article 7

1-1-1972

# The Misappropriation Doctrine: A Search for Literary Title Protection

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# THE MISAPPROPRIATION DOCTRINE: A SEARCH FOR LITERARY TITLE PROTECTION*

Since the 1964 United States Supreme Court's decisions in *Sears, Roebuck & Co. v. Stiffel Co.*[1] and *Compco Corp. v. Day-Brite Lighting, Inc.*,[2] state and lower federal courts have been vacillating over the vitality of the misappropriation doctrine of unfair competition.[3] This comment will discuss the response by California courts and federal courts in California to the *Sears* and *Compco* decisions. In particular, an examination will be made of the ramifications of a recent California case, *Tomlin v. Walt Disney Productions*,[4] in considering the vitality of the misappropriation doctrine. The author will also examine the status of protection for such literary property as titles, the subject at issue in *Tomlin*, and show how the unfair appropriation of titles can be effectively deterred within the dictates of the *Sears* and *Compco* decisions.

## UNFAIR COMPETITION: ITS ORIGIN AND GROWTH

### *Palming off: Unfair Use of a Competitor's Reputation*

Unfair competition originated as a separately recognized tort when courts first realized the need to provide protection for business when basic unfairness arose.[5] Originally, unfair competition was a valid claim only when palming off was proven.[6] Palming off is the sale by a party of his own product while taking advantage of the reputation or goodwill of a competitor by advertising or misrepresenting his product as that of his competitors.[7] While free competition was encouraged, conduct that violated existing standards of commercial morality, *e.g.*, palming off, was punished.[8]

### *Misappropriation: Unfair Use of a Competitor's Product*

The palming off theory restricted recovery to certain narrowly defined factual situations and due to the exigencies of business and

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* This paper will be entered in the 1972 Nathan Burkan Memorial Competition sponsored by the American Society of Composers, Authors and Publishers.

1 376 U.S. 225 (1964).

2 376 U.S. 234 (1964).

3 The source of this doctrine lies in the landmark case of *International News Service v. Associated Press*, 248 U.S. 215 (1918).

4 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971).

5 S. CHESTERFIELD OPPENHEIM, UNFAIR TRADE PRACTICES, 4 (2d ed. 1965).

6 Hanover Milling Co. v. Metcalf, 240 U.S. 403 (1916).

7 International News Service v. Associated Press, 248 U.S. 215 (1918).

8 OPPENHEIM, *supra* note 5, at 44.

technological growth palming off was not a satisfactory remedy. In the landmark case of *International News Service v. Associated Press*,[9] the United States Supreme Court recognized a need to extend common law protection to cases of misappropriation.[10] Misappropriation is an attempt by a second party to take advantage of the product itself; whereas in palming off, the second party takes advantage of the reputation or goodwill of a competitor.[11]

In the *INS* case International News Service copied news from Associated Press bulletin boards and early editions. International News Service then wired its newly acquired stories to certain West Coast papers, thereby getting news on the street at the same time or in advance of Associated Press. The Court in *INS* recognized that Associated Press had made a substantial investment in their news stories and enjoined International News Service from copying prior to publication by Associated Press and their realization of a profit.[12]

Immediately after *INS* most courts accepted the *INS* rationale and the misappropriation doctrine. For example, the misappropriation doctrine was applied to the appropriation of phonograph recordings,[13] professional athletics,[14] and in areas of literary property where copyright protection was not available.[15] As a result of *INS*, the misappropriation doctrine provided a flexible remedy to

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9 248 U.S. 215 (1918).

10 Sell, *The Doctrine of Misappropriation In Unfair Competition—The Associated Press Doctrine After Forty Years*, 11 VANDERBILT L. REV. 483 (1950). The author asserts that there is no real indication that the legislature could handle the problem. Any effort at defining unfair competition and misappropriation is useless since possibilities in this area are limited only by human ingenuity and vary with each new generation. The unique value of the misappropriation doctrine is its flexibility and applicability to changing problems of commerce.

11 248 U.S. at 240.

12 248 U.S. at 240-41. Mr. Justice Brandeis in dissenting considered the public need for free access to ideas and knowledge and was concerned with granting a property right with the privilege of exclusive control to such areas. However, the majority said: "[D]efendant, by its very act, admits that it is taking material that has been acquired by complainant as the result of organization and the expenditure of labor, skill, and money, . . . and that defendant in appropriating it and selling it as its own is endeavoring to reap where it has not sown . . ." *Id.* at 239.

13 Waring v. WDAS Broadcasting Station, Inc., 327 Pa. 433, 194 A. 631 (1937).

14 Pittsburgh Athletic Club v. KQV Broadcasting Co., 24 F. Supp. 490 (W.D. Pa. 1938).

15 Note, *Developments in the Law, Competitive Torts*, 77 HARV. L. REV. 888, 932 (1964). "Misappropriation, which shares with passing off the general label of unfair competition, is one of several legal doctrines concerning protection of intangibles of potential commercial value. These intangibles include ideas, information, formulas, designs and artistic creations, fame, goodwill, and performance of talent. . . . Misappropriation consists not in taking the physical object but in copying or drawing upon the conception or underlying intangible value for the use of the appropriator."

protect a party from predatory business practices without waiting for legislative reaction.[16]

*Sears and Compco: Reign of Obfuscation*

In 1964 the Supreme Court in *Sears, Roebuck & Co. v. Stiffel Co.*,[17] and *Compco Corp. v. Day-Brite Lighting, Inc.*,[18] held that copying the designs for a pole lamp and a fluorescent lighting fixture could not be prevented by Illinois State unfair competition laws where federal patent protection was unavailable. The Court said that a state cannot extend the life of a patent on an article or give a patent to an article which lacks the level of invention required for federal patents.[19]

If interpreted literally, the Supreme Court's decisions in the *Sears* and *Compco* cases established a *per se* rule against any state method of protection which has an effect of granting a monopoly.[20] Since these decisions, state courts and lower federal courts have been hopelessly bewildered as to the effect of *Sears* and *Compco* on the misappropriation doctrine as stated in *INS*.[21] This confusion stems from the fact that the Supreme Court did not discuss the vitality of *INS* and whether application of the misappropriation doctrine is still permissible.[22]

## California Treatment of the Misappropriation Theory After *Sears* and *Compco*

Immediately following *Sears* and *Compco* a federal court in California, in *Jerrold Stephens Co. v. Alladin Plastics, Inc.*,[23] rigor-

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16 Sell, *supra* note 10, at 498.

17 376 U.S. 225 (1964).

18 376 U.S. 234 (1964).

19 *Id.* at 239. Justice Harlan (concurring) argued that the states should have leeway to contend with predatory business practices where copying amounted to palming off.

20 Goldstein, *Federal System Ordering of the Copyright Interest*, 69 Colum. L. Rev. 49, 69 (1969). The author explains that application of the *INS* rationale requires that each case be examined on its facts to determine the effect on the competition-monopoly balance. However, *Sears* and *Compco* if interpreted literally posit a rigid policy designed to shift the balance to free competition. *Id.* at 64.

21 There has been a split within the courts with regard to the vitality of the misappropriation doctrine. For approval of continued use *see* Grove Press, Inc. v. Collectors Publication, Inc., 264 F. Supp. 603 (C.D. Cal. 1967); KMLA Broadcast Corp. v. Twentieth Century Cig. Vend. Corp., 264 F. Supp. 35 (C.D. Cal. 1967); Pottstown Daily News Pub. Co. v. Pottstown Broadcasting Co., 247 F. Supp. 578 (E.D. Pa. 1965). *Contra*, Columbia Broadcasting System, Inc. v. De Costa, 377 F.2d 315 (1st Cir. 1967); Cable Vision, Inc. v. KUTV, Inc., 335 F.2d 348 (9th Cir. 1964).

22 Goldstein, *supra* note 20, at 72, where the author states that courts read *Sears* and *Compco* as prohibiting state injunction against copying but not against misappropriation.

23 229 F. Supp. 536 (S.D. Cal. 1964).

ously applied *Sears* and *Compco*. In *Stephens* the plaintiff depended upon the federal patent law for protection of his bucket-shaped plastic seats. The court said that where a party depends on federal patent law he cannot recover under state common law or a state statutory claim of unfair competition.[24]

However, the misappropriation theory was held to be still valid in *Grove Press, Inc. v. Collectors Publication, Inc.*,[25] where *Sears* and *Compco* were limited to their facts. The plaintiff, Grove Press, published a version of a book no longer protected under the federal copyright law with some basic grammatical changes. The book, *My Secret Life,* the story of an anonymous gentleman, was originally printed in the late 19th century. The changes in grammar from the original were considered trivial, and copyright protection was not applicable since the required level of originality was lacking. The defendant, Collectors Publication, Inc., made a photographic copy of the book and reproduced it using an offset lithographic process. The court, in implementing the *INS* rationale and the misappropriation doctrine, said that, in view of Grove Press's expenditure of substantial sums in setting type and engraving plates, it would constitute unfair competition for the defendants to appropriate the value and benefit of such expenditure to themselves.[26] The court in *Grove Press* issued a temporary injunction, stating that wrongful appropriation of the property of another is unfair competition and redressable in spite of the holdings in *Sears* and *Compco*.[27]

Throughout the *Sears* and *Compco* decisions, the Court juxtaposed its discussion of patents with a reference to copyrights. The *Grove Press* decision illustrates the use of the misappropriation theory where copyright protection is unavailable.[28] Although the Court in *Compco* said that the states cannot invoke methods to prohibit copying,[29] the court in *Grove Press* distinguished their case, not on the rationale that copying was prohibited, but that the means used was unlawful.[30] The court reasoned that to allow copying by photography and the offset lithographic process would make plaintiff's expenditures, as compared with the defendant's, an unfair burden. Consequently, an equitable result was achieved despite the limitations of the *Sears* and *Compco* cases.

State protection from copying would appear to violate the *per se*

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[24] *Id.* at 539.
[25] 264 F. Supp. 603 (C.D. Cal. 1967).
[26] 264 F. Supp. at 606-7.
[27] *Id.* at 606.
[28] OPPENHEIM, *supra* note 5, at 208-9.
[29] 376 U.S. 234, 237-38 (1964).
[30] 264 F. Supp. 603, 607 (1967).

rule of *Sears* and *Compco* against any state method of extending monopoly-type protection.[31] However, the court in *Grove Press* implemented the misappropriation doctrine just as the Supreme Court did in *INS*, where plaintiff could not recover under federal copyright law. One writer suggests that the fact that the federal copyright law is not as comprehensive as the patent law indicates that the preemption principles expounded in *Sears* and *Compco* were not intended to resolve problems peculiar to the copyright law.[32] Whether or not this suggestion is valid, the misappropriation doctrine has been used to complement copyright protection.

The misappropriation doctrine was also upheld in *Tape Industries Association of America v. Younger*,[33] where the plaintiff made tapes of phonograph recording discs and sold them as his own product. Interestingly, the court in *Tape Industries* applied the *INS* rationale while upholding the California "tape piracy" statute.[34] The statute, making it an offense to steal or appropriate another's saleable product, was held not to contravene federal policies as enunciated in *Sears* and *Compco*.[35]

Thus, both *Grove Press* and *Tape Industries* granted limited protection against appropriation or the use of one's product by another for profit. Presumably, both would contravene the *Sears* and *Compco* dictates if the latter cases were rigorously applied. However, the grant of monopoly protection in *Grove Press* and *Tape Industries* is *de minimis*; the plaintiff has an action against only the offending party for unfair means of appropriation and the public at large is still free to copy. The effect of the *Sears* and *Compco* decisions is to make it clear that free competition is the paragon of business, and the grant of a monopoly with exclusive control is contrary to the public good, unless allowed by federal law. In *Grove Press* and *Tape Industries* the spirit of *Sears* and *Compco* to deny extended monopoly protection is clearly followed; only limited protection is granted to prevent competitors from appropriating a product under circumstances where they will gain an unfair advantage in the business market.

## Title Piracy: An Insidious Practice[36]

Although the *Sears* and *Compco* decisions were concerned with

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31 *See* text accompanying notes 17-22, *supra*.

32 Kestenbaum, *The Sears and Compco Cases: A Federal Right to Compete By Copying*, 51 A.B.A.J. 935, 938 (1965).

33 316 F. Supp. 340 (C.D. Cal. 1970).

34 Cal. Pen. Code § 653(h) (West 1968).

35 Tape Industries Association of America v. Younger, 316 F. Supp. at 351.

36 The undesirability of literary title piracy was discussed at length in *Johnston*

invalid design patents, the dictates of those decisions have been extended to the area of literary titles. In *Tomlin v. Walt Disney Productions*,[37] the composer of a song alleged unfair appropriation of his title. The composer primarily sought an injunction to prevent the use of his title, "The Love Bug Will Bite You (If You Don't Watch Out)," by Walt Disney Productions in their movie, *The Love Bug*.[38] Tomlin contended that Walt Disney Productions had appropriated Tomlin's popular title without paying for this privilege.[39] The court said, however, that recovery for title misappropriation requires that the title in question have a secondary meaning.[40] Secondary meaning is a subsequent significance in addition to the original meaning of a word group which becomes its primary significance to the public.[41] The concept of secondary meaning has been extended to areas of literary property, such as titles, where the name is recognized as being distinctive.[42] The court in *Tomlin*

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*v. 20th Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 817, 187 P.2d 474, 487 (1947). The court said: "The title . . . was produced by shrewd calculation. It is an original combination, a catchy phrase. It had sales appeal. Much energy, time and money were spent in popularizing it. A thing of such great value should not only be protected but should be subject to transfer for use. There is no valid reason why it should not be held that a transferable property right exists in use of a title of a book, such as this, for motion picture and other ends."

[37] 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971). *See also* Klein, *Is Unauthorized Use of Titles of Artistic Works In Unrelated Fields Actionable Piracy?*, 28 BROOKLYN L. REV. 59, 66-67 (1962).

[38] As explained in *Tomlin*: "Persons are often described as having been bitten by 'The Golf Bug,' 'The Acting Bug,' 'The Gambling Bug,' 'The Travel Bug,' as well as 'The Love Bug.'" Tomlin v. Walt Disney Productions, 18 Cal. App. 3d 226, 229 n.1, 96 Cal. Rptr. 118, 119 n.1 (1971).

[39] *Id.* at 229, 96 Cal. Rptr. at 119.

[40] *Id.* at 230, 96 Cal. Rptr. at 120.

[41] *See also* OPPENHEIM, *supra* note 5, at 67. "The phrase 'secondary meaning,' as thus used does not mean a subordinate or rare significance. It means rather a subsequent significance added to the previous meaning of the designation and becoming in the market its usual and primary significance." For a typical state court interpretation of this concept *see* Hemingway v. Film Alliance, 174 Misc. 725, 726, 21 N.Y.S.2d 827, 828 (1940). The court held that: "[W]here a play has attained such popularity that its title has acquired a secondary meaning, one associated with or suggestive of the play, a rival producer will not be permitted to use or simulate the title, or any part of it, in such manner as to deceive or mislead the theatre-going public into believing that the latter production is a motion picture version of the earlier play."

[42] *See* for example NIMS, THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS, § 37 at 154 (4th ed. 1947), quoted in Gordon v. Warner Bros. Pictures, Inc., 269 Cal. App. 2d 31, 35, 74 Cal. Rptr. 499, 502, which provides a summary of the secondary meaning rule: "Primarily, it would seem that one might appropriate to himself for his goods any word or phrase that he chose; but this is not so, because the broader public right prevails, and one may not appropriate to his own exclusive use a word which already belongs to the public. . . . [The theory of secondary meaning] contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer with reference to his article that, in that trade and to that branch of the purchasing public, the word or phrase had come to mean that the article was his product; in other words, had come to be, to them, his trademark."

denied relief, reasoning that the song title had not achieved the necessary recognition by the public to acquire a secondary meaning.[43]

Significantly, the court in *Tomlin* stated that the misappropriation theory as a method of protection for literary titles is no longer a proper means of relief, losing its vitality in the *Sears* and *Compco* decisions.[44] The *Tomlin* decision was undoubtedly correct on its facts. However, the court's *dictum* which denounced the misappropriation doctrine as a viable theory of protection is in this author's opinion both unfortunate and incorrect. *Grove Press* and *Tape Industries* suggest but two factual situations where the misappropriation doctrine can be applied without offense to the strict limitations on copyright protection announced in *Sears* and *Compco*. Protection of titles by the misappropriation doctrine may frequently be the singular means of relief and it should be applied to prevent inequitable business practices.

Prior to *Tomlin* an action for unfair appropriation of a title could only be maintained if the title had acquired a secondary meaning.[45] Relief under this theory is necessary since titles are not considered a writing and are not protected by federal copyright law.[46] Despite federal preemption in some areas, a concept reaffirmed in *Sears* and *Compco*, states can grant common law copyright protection of an author's right to the first publication of his work.[47] One writer observes that state courts and lower federal courts have often given protection through the misappropriation-common law copyright nexus as a facile means to escape the broad dictates of *Sears* and *Compco*.[48] Examples of this method of circumventing *Sears* and *Compco* are the *Grove Press* and *Tape Industries* decisions.[49] In these cases the misappropriation doctrine was applied despite the the fact that the products involved did not qualify for federal statutory copyright protection.

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[43] 18 Cal. App. 3d 226, 237-38, 96 Cal. Rptr. 118, 120 (1971).

[44] *Id.* at 230, 96 Cal. Rptr. at 122.

[45] *Id.* at 230, 96 Cal. Rptr. at 120.

[46] *See* 17 U.S.C. § 4 (1959). "The works for which copyright may be secured under this title shall include all the writings of an author." For a statement of the rule that titles are not copyrightable *see* Harms, Inc. v. Tops Music Enterprises, Inc., 160 F. Supp. 77, 81 (S.D. Cal. 1958).

[47] 17 U.S.C. § 2 (1959). "Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor."

[48] P. Goldstein, *Federal System Ordering of the Copyright Interest*, 69 COLUMBIA L. REV. 49, 72 (1969).

[49] *See* text accompanying notes 25-35, *supra*.

In *Jackson v. Universal International Pictures*,[50] decided before *Tomlin*, the court held that the author of a play, *Slightly Scandalous*, could successfully recover for the appropriation of his title which had a secondary meaning.[51] One writer criticizing *Jackson* urged automatic protection for distinctive non-descriptive titles stating that only a title which is the natural and necessary description of the work needs a secondary meaning to receive protection.[52] One way to grant automatic protection for the distinctive non-descriptive title would be to provide for registration of literary titles through an amendment to the Trade Mark Act; this would provide immediate protection for non-descriptive titles and would still allow authors with a descriptive title to receive protection by proving secondary meaning. Traditionally, a trade-mark identifies goods used by a businessman to distinguish them from goods sold by others.[53] Arguably, the title in *Jackson* is designed to be distinctive and use by another should not be allowed.[54]

In *Johnston v. 20th Century-Fox Film Corp.*,[55] the court found secondary meaning in the title of a book, *Queen of the Flat Tops*. The court stated that this title, which was used to describe an aircraft carrier, was non-descriptive, arbitrary and fanciful; the use of such a title by another for radio, motion pictures, dramatic or television productions would unfairly compete with the author.[56] Furthermore, the court stated that secondary meaning is not necessary to obtain protection of a title which is distinctive.[57]

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50 36 Cal. 2d 116, 222 P.2d 433 (1950).

51 36 Cal. 2d at 122, 222 P.2d 433, 436 (1950). *See also* Hemingway v. Film Alliance, 174 Misc. 725, 21 N.Y.S.2d 827, 829 (1940). "The likelihood of deception is enough . . . . [A] vast field of words and phrases is open to a producer who wishes to seek a title to distinguish his play or photoplay from that of another. . . . It will affect not only the moving picture rights in their play, but the further presentation of the play itself."

52 3 R. CALLMAN, LAW OF UNFAIR COMPETITION, 890 n.40 (3rd. ed. 1969).

53 OPPENHEIM, *supra* note 5, at 66.

54 The requirement that a title achieve a special significance with the public is explained in Netterville, *Piracy and Privilege in Literary Titles*, 32 S. CAL. L. REV. 101, 113 (1959) where the author states: "Since the title of a literary work is the generic, common, and only designation by which the public knows the work, the title can never qualify as a technical trademark." *Contra* CALLMAN, *supra*, note 52, 888-90 where the author explains that a title which is the natural and necessary description of the work is not freely selected since the nature of the work dictates the title; however, a title which is non-descriptive, freely selected and sharply distinguishes the work from all others does not need a secondary meaning. Literary title piracy has been rampant of late and should not be encouraged.

55 82 Cal. App. 2d 796, 187 P.2d 474 (1947).

56 *Id.* at 809, 817, 187 P.2d at 482, 487.

57 *Contra* Colvig v. KSFO, 224 Cal. App. 357, 369, 36 Cal. Rptr. 701, 708 (1964). "[S]ince titles to literary works are usually descriptive and their protection dependent upon secondary meaning, the general principles of the law of unfair competition apply."

The *dictum* in *Johnston* to grant exclusive protection to titles that are non-descriptive, without proof of secondary meaning, was critized in *Gordon v. Warner Bros. Pictures, Inc.*[58] As the court in *Gordon* pointed out, the suggestion to grant trade-mark protection for literary titles is contrary to established law. However, by extending registration under the Trade Mark Act to non-descriptive titles, federal protection would be provided without conflicting with the *Sears* and *Compco* decisions. Thus, an effective means of protecting an original idea of commercial value would be provided.

In *Gordon* the author of a novel, *The FBI Story*, alleged unfair appropriation of his title. However, the court, to avoid any possible conflict with *Sears* and *Compco*, required proof of palming off.[59] Thus, Gordon had to show that the defendant used his title with an intent to deceive the public. This proved to be an insurmountable burden since the defendant's title had possibly been taken from a nonfiction book entitled, *The FBI Story, A Report to the People.*

In *Gordon*, the plaintiff had a contract option with Gramercy Pictures, Inc., for the use of his title.[60] To digress for a moment, suppose Gordon had been able to prove that the defendant had unfairly appropriated his title. This would create an inequitable situation that calls for the application of the misappropriation doctrine. The rationale for granting relief would be that, after much time and expense in popularizing his title, Gordon was about to realize a profit from the title he had developed by contracting with another for its use.[61] Where a party has popularized a title and made it a valuable commodity, another party should not be allowed to nullify the first's efforts to realize a profit.[62] Just as the Court in *INS* enjoined International News Service from interference with Associated Press at the crucial period when profit was to be realized, a court should enjoin a defendant who misappropriates a title.

To deter title piracy, courts should allow protection of a title against competitors in related fields.[63] Implementing the *INS* rationale, a limited right to use the literary title would be granted until its commercial value to the owner ceased.[64] *Sears* and *Compco* stand

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[58] 269 Cal. App. 2d 31, 35 n.1, 74 Cal. Rptr. 499, 501 n.1 (1969).

[59] In *Sears* the court stated, "Obviously a State could not, consistently with the Supremacy Clause of the Constitution, extend the life of a patent beyond its expiration date or give a patent on an article which lacked the level of invention required for federal patents." Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 231 (1964).

[60] 269 Cal. App. 2d 31, 34, 74 Cal. Rptr. 499, 500-01 (1969).

[61] *See* text accompanying notes 11-15, *supra.*

[62] International News Service v. Associated Press, 248 U.S. 215, 239 (1918).

[63] Hemingway v. Film Alliance, 174 Misc. 725, 21 N.Y.S.2d 827, 829 (Sup. Ct. 1940), *see also* note 51, *supra.*

[64] International News Service v. Associated Press, 248 U.S. 215, 245 (1918).

against any perpetual monopoly. However, to originators of a title associated with the work it identifies, only a limited right against competitors would be given. This grant of limited protection to realize commercial value might necessitate a change in the traditional requirement by the courts that literary titles have a secondary meaning. One approach was suggested by a court that granted protection under the misappropriation doctrine.[65] This court granted relief on the basis of public familiarity, an arguably subjective standard somewhat less demanding than secondary meaning.[66] The test of familiarity would be an issue of fact to be decided in each case.

A final consideration of the above suggestions indicates that a grant of limited protection to literary titles, against competitors in related fields, would discourage title piracy, promote free competition by rewarding individual ingenuity, and alleviate unfair appropriation for commercial gain. The court in *Tomlin v. Walt Disney Productions*,[67] said that the theory of misappropriation for literary titles is no longer valid.[68] However, such a dogmatic statement fails to take into account the varied problems in business, the need for courts to have a flexible means to adopt changes, and the need for an effective remedy to provide relief when inequities arise. The misappropriation doctrine is such a flexible tool, as illustrated in the *Grove Press* and *Tape Industries* cases. Consequently, the misappropriation doctrine should be implemented, where appropriate, in the area of literary titles in order to allow the originator to realize commercial gain on a title that he has popularized and made valuable.

## FAIRNESS: A TREND IN TRADE NAMES THAT SHOULD APPLY TO TITLES

Continued vitality of the misappropriation doctrine stands as mute testimony that dogmatic application of the *Sears* and *Compco* decisions is inimical to the law of unfair competition. The desire of the courts to encourage fairness in other areas of business can be illustrated in the area of trade name protection. An example of this trend is *Ball v. American Trial Lawyers Association*,[69] where two associations of attorneys contested the future use of defendant's trade name. Plaintiff, the American College of Trial Lawyers, is

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65 Flexitized, Inc. v. National Flexitized Corp., 335 F.2d 774 (2d Cir. 1964), *cert. denied*, 380 U.S. 913 (1964).

66 *Id.* at 781.

67 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971).

68 *Id.* at 230, 96 Cal. Rptr. at 122.

69 14 Cal. App. 3d 289, 92 Cal. Rptr. 228 (1971).

an unincorporated association whose membership is highly selective .[70] Defendant, American Trial Lawyers Association, is a large national association originally composed of attorneys who practiced in the workmen's compensation field. On August 2, 1964, defendant adopted its present name, American Trial Lawyers Association, despite a discussion with the plaintiff concerning the possibility of confusion surrounding the two names. On appeal the court granted a final injunction against the use of the name "American Trial Lawyers Association" by defendant and discussed the trend in the law which made a verdict for the plaintiff possible.[71] The court stated that the emphasis in the law is now on "unfairness" rather than competition.[72] Direct competition is no longer necessary; it is enough if the unfair practices of one party will injure the other party.[73]

The name, American College of Trial Lawyers, was held to have acquired a secondary meaning,[74] giving the name a special significance in the community, especially to the narrow segment that comprised the profession involved.[75] The court stated that it is not the word "college" which is distinctive but the entire name.[76] The

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[70] CAL. CORP. CODE § 21000 (West 1955) states: "A nonprofit association is an unincorporated association of natural persons for religious, scientific, social, literary, educational, recreational, benevolent, or other purpose not that of pecuniary profit."

[71] In Ball v. American Trial Lawyers Ass'n., 14 Cal. App. 3d 289, 301, 92 Cal. Rptr. 228, 236 (1971), the court said: "While this case appears to be the first instance in which this particular facet of the 'doctrine of unfair competition' is invoked as the basis of relief in a dispute between two nonprofit organizations of the kind here involved, we think . . . it should . . . be applied."

[72] *Id.* at 303, 92 Cal. Rptr. at 237. *See also* Wood v. Peffer, 55 Cal. App. 2d 116, 122, 130 P.2d 220, 224 (1942), "[I]t has been held that there must be actual competition before there can be any unfair competition, and that there cannot be competition unless there is something to compete with. However, the tendency of the courts has been to widen the scope of protection in the field of unfair competition. They have held that there is no fetish in the word 'competition,' and that the invocation of equity rests more vitally on the element of unfairness." *Accord,* Sunset Housing Distr. Corp. v. Coffee Dans, Inc., 240 Cal. App. 2d 748, 50 Cal. Rptr. 49 (1966).

[73] Ball v. American Trial Lawyers Association, 14 Cal. App. 3d at 305, 92 Cal. Rptr. at 238. *See also* Academy of Motion Picture Arts and Sciences v. Benson, 15 Cal. 2d 685, 104 P.2d 650 (1940), where the court found "that direct competition is not necessary" and granted an injunction. Plaintiff gave Oscar awards, and the defendant school, "The Hollywood Motion Picture Academy," trained hopeful actors. The parties were not directly competitive, but the injunction was granted because defendant's use of the name would deceive the public.

[74] *See* note 42 *supra.*

[75] Ball v. American Trial Lawyers Association, 14 Cal. App. 3d 289, 302, 92 Cal. Rptr. 228, 236 (1971). The court found the legal community acceptable for the test of secondary meaning but said, "[W]e feel that the relevant public includes that cross-section of the populace who may come into contact with the names or the respective reputations of either organization, the activities of either organization or of its respective members, or the official positions or views of either organization upon contemporary controversial legal problems." *Id.* at 308, 92 Cal. Rptr. at 241.

[76] *Id.* at 307, 92 Cal. Rptr. at 240. "It is the impression which the tradename as a whole creates on the average reasonably prudent member of the relevant public and not the parts thereof which is important." *Id.* at 307, 92 Cal. Rptr. at 240. *See also*

test of possibility of confusion is whether the average member of the public who may come into contact with either association would be confused; the use of the name, American Trial Lawyers Association, by defendant made confusion likely.[77] The result of such confusion, injury to reputation or goodwill, was of primary concern to the court in reaching its decision.[78]

The *Ball* case illustrates the courts' desire to emphasize fairness.[79] The trade name problem in *Ball* is analagous to that of literary titles discussed in *Johnston v. 20th Century-Fox Film Corp.*[80] In *Johnston*, the court held that the title, *Queen of the Flat Tops*, had acquired a secondary meaning.[81] Similarly, in *Ball* the court found that plaintiff's name, American College of Trial Lawyers, had acquired a secondary meaning which qualified for trade name protection. A literary title which has a secondary meaning should receive protection. Furthermore, a title that meets a somewhat less demanding standard, *e.g.*, the test of public familiarity,[82] should also be protected. Unfair appropriation of literary titles should not be tolerated.

## CONCLUSION

The emphasis in unfair competition law in the last few years has been on unfairness as illustrated in the case of *Ball v. American Trial Lawyers Association.*[83] Inequities in business should not be countenanced by the courts, especially where someone appropriates the product of another. Federal copyright and patent laws which give limited monopoly protection recognize the public need for access

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American Automobile Ass'n. v. American Automobile Owners' Ass'n., 216 Cal. 125, 13 P.2d 707 (1932).

77 14 Cal. App. 3d 289, 308, 92 Cal. Rptr. 228, 241. *See also* Stork Restaurant v. Sahati, 166 F.2d 348 (9th Cir. 1948); Academy of Motion Picture Arts and Sciences v. Benson, 15 Cal. 2d 685, 140 P.2d 690 (1940).

78 14 Cal. App. 3d 289, 305, 92 Cal. Rptr. 228, 238. *Accord* Yale Electric Corp. v. Robertson, 26 F.2d 972, 974 (2d Cir. 1928).

79 *See* Academy of Motion Picture Arts and Sciences v. Benson, 15 Cal. 2d 685, 104 P.2d 650 (1940), where the court said: "[W]ithout regard as to whether there is actual market competition between the parties for the same trade, it is sufficient if the unfair practices of the one will injure the other." *Id.* at 689, 104 P.2d at 652.

80 82 Cal. App. 2d 796, 187 P.2d 474 (1947).

81 *Id.* at 813, 187 P.2d 474. *Accord* Estes v. Williams, 21 F. 189 (S.D.N.Y. 1884), where the title of a book for children, "Chatterbox," was held to have acquired a secondary meaning and the author given the exclusive right to place his work upon the market. This was not a right to prevent copying but a right to be free from misrepresentations that another work was plaintiff's when put upon the market. This right allows the author the fair enjoyment of the reputation of his work, which fully belongs to him. "It deprives others of nothing that belongs to them." *Id.* at 190.

82 *See* text accompanying notes 65-66, *supra.*

83 92 Cal. Rptr. 228, 14 Cal. App. 3d 289 (1971).

to certain products and ideas.[84] But in cases of unfair appropriation free competition is not present—the pirate is rewarded not the creator; any argument that relief against such piracy perpetuates a monopoly is myopic and unsound.

In *Tomlin v. Walt Disney Productions*,[85] the court dealt with the problem of appropriation of literary titles; unfortunately the court used very broad language to declare misappropriation an effete doctrine. The misappropriation doctrine is an effective means of relief, however, as illustrated in *Grove Press, Inc. v. Collectors Publication, Inc.*[86] and *Tape Industries Association of America v. Younger*.[87] Furthermore, to originators of a title associated with the work it identifies a limited right to realize commercial value should be given.

The misappropriation doctrine along with other theories of protection such as palming off, deter unfair competition and should be considered in title cases if appropriate. When basic unfairness arises in business, the courts need a remedy to counteract an unhealthy business environment which encourages the unfair use of another's saleable product. For fifty-three years the misappropriation doctrine has been a flexible and effective means of protecting individuals from another person's use of their product for profit. It should not be abandoned.

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[84] An individual may secure exclusive rights for a limited time, 17 years in the case of a patent and a term of 28 years with a right of one renewal for another 28 years in the case of a copyright. For general treatment of these areas *see* OPPENHEIM, *supra* note 5, 201-29.

[85] 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971).

[86] 264 F. Supp. 603 (C.D. Cal. 1967).

[87] 316 F. Supp. 340 (C.D. Cal. 1970).